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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,043	03/24/2000	Toshiaki Shinohara	0057-2608-2YY	3123

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EXAMINER

CHU, CHRIS C

ART UNIT PAPER NUMBER

2815

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/534,043

Applicant(s)

SHINOHARA ET AL.

Examiner

Chris C. Chu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 5, 7, 8 and 13 - 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3 - 5, 7 and 13 - 16 is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 2, 2004 has been entered. An action on the RCE follows.
2. Applicant's amendment filed on January 2, 2004 has been received and entered in the case.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Hirose et al.

Hirose et al. discloses in Fig. 5, Fig. 16B and column 10, lines 16 ~ 19 a semiconductor module mountable on an external heat sink (5), the semiconductor module comprising:

- an insulating substrate (1, 11, and 8) for the semiconductor module, the insulating substrate (1, 11, and 8) including a substrate (1), a first conductive pattern (8) formed on a first main surface of the substrate which is on the opposite side from the external heat sink, and a second conductive pattern (11) formed on a second main surface of the substrate which is on the same side as the external heat sink and for contact with the external heat sink;
- a mounting frame (3) made of metal and having a mounting surface for contact with the external heat sink, the mounting frame (3) including a flange along a periphery thereof for engagement with a peripheral part of the insulating substrate at the first main surface, the flange pressing the peripheral part of the insulating substrate toward the external heat sink to force the insulating substrate into pressure contact with the external heat sink,
- wherein the substrate, the first conductive pattern and the second conductive pattern of the insulating substrate have respective peripheries in alignment with each other, and
- wherein the flange presses the periphery of the first conductive pattern on which a semiconductor element is mounted toward the external heat sink with an insulative material (air ^{gap} between the element 3 and the element 2; ~~see R2 in Fig. 5~~) between the flange and the first conductive pattern.

at the left side of element 2

Allowable Subject Matter

5. Claims 7, 13 and 14 are allowed (see previous office action).

6. Claims 1, 3 - 5, 15 and 16 are allowed.

a. The following is an examiner's statement of reasons for allowance:

The prior art of record does not teach or reasonably suggest, either singularly or in combination, at least a mounting metal frame having a mounting surface for direct contact with an external heat sink, the mounting frame including a flange along a periphery thereof for engagement with a peripheral part of the insulating substrate at the first main surface, the flange pressing the peripheral part of the insulating substrate toward the external heat sink, wherein the mounting frame further includes: a first metal plate having the mounting surface, and a second metal plate disposed directly on and in contact with the first metal plate and having a protrusion along a periphery thereof projecting from a periphery of the first metal plate to define a flange.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Response to Arguments

2. Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

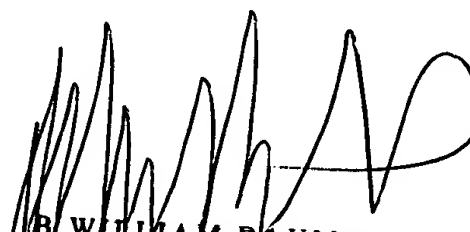
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris C. Chu whose telephone number is (703) 305-6194. The examiner can normally be reached on M-F (10:30 - 7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (703) 308-2772. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Chris C. Chu
Examiner
Art Unit 2815

c.c.
1/25/04 8:34:43 PM



B. WILLIAM BAUMEISTER
PRIMARY EXAMINER

B. WILLIAM BAUMEISTER
PRIMARY EXAMINER